



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/814,552	03/22/2001	Henry H. Wheeler JR.	7014-101	4477
167	7590	05/17/2006	EXAMINER	
FULBRIGHT AND JAWORSKI LLP 555 S. FLOWER STREET, 41ST FLOOR LOS ANGELES, CA 90071			SERGENT, RABON A	
			ART UNIT	PAPER NUMBER

1711

DATE MAILED: 05/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/814,552

Applicant(s)

WHEELER ET AL.

Examiner

Rabon Sergent

Art Unit

1711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 March 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 15-17 and 37-47 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 15-17 and 37-47 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

Art Unit: 1711

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on February 17, 2006 has been entered.

2. Claims 15-17 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a nozzle having a tip diameter of 0.21 to 0.45 thousandths of an inch, does not reasonably provide enablement for nozzles having tip diameters exceeding 0.45 thousands of an inch. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make the invention commensurate in scope with these claims. Applicants have disclosed that that the aforementioned feature is a characteristic of the nozzle and have failed to provide enablement for the use of larger tip diameters. The position is taken that the skilled artisan could not practice the invention as claimed without resorting to undue experimentation. *In re Wands*, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988).

3. Claims 15-17 and 47 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Within the last line of claims 15 and 47, applicants have stated that the device is capable of spraying a mixture of the first and second polymerization materials from said check valve onto a surface. This language renders the claims indefinite, because it calls into question the

Art Unit: 1711

structure and mode of operation of the device, since it would seem that the mixture should actually be sprayed from the nozzle as opposed to the check valve.

4. Claims 15-17 and 47 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Applicants have failed to provide enablement for a device capable of spraying directly from a check valve onto a surface; however, applicants have claimed that the device is capable of such an operation. Applicants have only provided enablement for devices that spray from the nozzle tip. *In re Wands*, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988).

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 1711

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 37, 39, and 40 are rejected under 35 U.S.C. 102(b) as being anticipated by Adam et al. ('677).

Patentees disclose a ditch liner, wherein a porous blanket is impregnated with a polyurethane composition containing a filler material, including aramid fibers. See abstract and column 3, line 59. Since the ditch liner is intended to contain fluids, such as water, the position is taken that the pores of the blanket have been filled with the polyurethane material. Though patentees fail to disclose the porous blanket as specifically being a geotextile, the position is taken in view of the disclosed application of the liner that the porous blanket functions as a geotextile and that one of ordinary skill in the art would immediately envisage the blanket as being a geotextile. Lastly, since the instant claims are drawn to the liner article, the means by which the polyurethane has been applied (spraying) does not distinguish the claims from the prior art, absent a showing of distinction attributable to the method.

7. Claim 38 is rejected under 35 U.S.C. 103(a) as being unpatentable over Adam et al. ('677).

Art Unit: 1711

As aforementioned within paragraph 6, patentees disclose a ditch liner, wherein a porous blanket, considered to meet applicants' geotextile, is impregnated with a polyurethane composition containing a filler material, including aramid fibers. Patentees fail to disclose applicants' claimed polyurethane thickness; however, the selection of the claimed thickness amounts to nothing more than the optimization of a result effective variable. Accordingly, it would have been obvious to apply the polyurethane at virtually any thickness adequate for the intended purpose of forming a liner.

8. Claims 37, 39-41, and 43-45 are rejected under 35 U.S.C. 102(e) as being anticipated by Markusch et al. ('407).

Patentees disclose a liner, wherein a geotextile is impregnated with a polyurethane composition containing a filler material, including aramid fibers. See abstract and column 7, line 26. Since the liner is intended to contain fluids, such as water, the position is taken that the pores of the geotextile have been filled with the polyurethane material. Patentees further disclose at column 8, lines 5+ that the polyurethane may be applied to the geotextile by spraying.

9. Claims 38 and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Markusch et al. ('407).

As aforementioned within paragraph 8, patentees disclose a liner, wherein a geotextile is impregnated with a polyurethane composition containing a filler material, including aramid fibers. Though patentees disclose that the thickness of the composite can be varied over a wide range, patentees fail to disclose applicants' claimed polyurethane thickness; however, the selection of the claimed thickness amounts to nothing more than the optimization of a result

Art Unit: 1711

effective variable. Accordingly, it would have been obvious to apply the polyurethane at virtually any thickness adequate for the intended purpose of forming a liner.

10. Claim 46 is rejected under 35 U.S.C. 103(a) as being unpatentable over Markusch et al. ('407) in view of White ('245).

As aforementioned, Markusch et al. disclose a liner for containing fluids, wherein a geotextile is impregnated with a polyurethane composition containing a filler material, including aramid fibers. See abstract and column 7, line 26. Patentees further disclose at column 8, lines 5+ that the polyurethane may be applied to the geotextile by spraying.

11. Markusch et al. are silent with respect to the process steps of claim 46; however, in the production of liners and lined containers, the position is taken that such process steps would have been obvious at the time of invention. This position is supported by the teachings of White. White discloses at column 1, lines 45+ and column 3, lines 62+ the adhesive bonding of geotextiles to substrates to produce liners for tanks, and White further stresses the need to provide a means for gas to escape from between the liner and the substrate walls as the tank is filled. The position is ultimately taken that it would have been obvious to utilize a structurally superior liner, such as that produced by Markusch et al., in the production of tanks in accordance with the teachings of White and further to provide a means for the aforementioned gas to escape, such as by not sealing the perimeter of the geotextile with adhesive.

Any inquiry concerning this communication should be directed to R. Sergent at telephone number (571) 272-1079.

R. Sergent
May 15, 2006


RABON SERGENT
PRIMARY EXAMINER